

Patent
Attorney's Docket No. ATL99003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of)

Denise E. Smith et al.)

Application No.: 09/611,196)

Filed: July 6, 2000)

For: SYSTEMS AND METHODS)
RELATING TO)
MULTIPURPOSE CARDS)

Group Art Unit: 2643

Examiner: R. Barnie

#23
5-29-04
JN

RECEIVED

MAY 25 2004

Technology Center 2600

TRANSMITTAL FOR REPLY BRIEF

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Appeal Brief - Patents
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

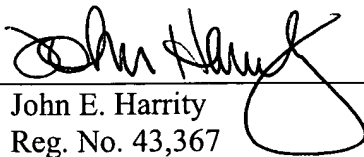
Submitted herewith in triplicate is Appellant's Reply Brief in response to the Examiner's Answer mailed March 24, 2004, in the above-identified application.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 13-2491.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By: _____


John E. Harrity
Reg. No. 43,367

11240 Waples Mill Road, Suite 300
Fairfax, Virginia 22030
(571) 432-0800

Date: May 21, 2004



PATENT
Attorney Docket No. ATL99003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of)
Denise E. SMITH et al.) Group Art Unit: 2643
Application No.: 09/611,196) Examiner: R. Barnie
Filed: July 6, 2000)
For: SYSTEMS AND METHODS)
RELATING TO MULTIPURPOSE CARDS)

RECEIVED

MAY 25 2004

Technology Center 2600

REPLY BRIEF UNDER 37 CFR § 1.193

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Appeal Brief - Patents
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, mailed March 24, 2004.

At the outset, Appellants note that the Examiner alleges in the Examiner's Answer that the Examiner does not agree with Appellants' grouping of claims "because all the claims 8-13, 19, 20, 23 27 and 29 should stand or fall with its independent claims" (Examiner's Answer, page 2). Appellants strenuously disagree.

In Appellants' Appeal Brief, Appellants presented separate arguments of patentability with respect to claims 8-13, 19, 27, and 29. Accordingly, for at least the reasons set forth in the Appeal Brief, these claims stand or fall alone and not with their respective independent claims.

Moreover, as set forth in Section VII of the Appeal Brief, Appellants submit that claims 20 and 23 stand or fall together. Appellants chose claim 20 as representative of the group of claims including claims 20 and 23 and provided separate arguments with respect to the patentability of this group. The Examiner has not provided any evidence that Appellants' grouping with respect to claims 8-13, 19, 20, 23, 27, and 29 is in error. Therefore, Appellants submit that the Examiner's allegation that claims 8-13, 19, 20, 23, 27, and 29 should stand or fall with their respective independent claims is without merit.

In the Response to Arguments section of the Examiner's Answer (pages 10-16), the Examiner addressed the following arguments from the Appeal Brief, filed December 30, 2003: (1) with respect to claim 1, the Examiner alleges Holstrom and Taskett disclose the features of claim 1 (Examiner's Answer, page 10); (2) further with respect to claim 1, Holstrom does not disclose a multipurpose calling card including a calling card portion and a key tag portion (Examiner's Answer, pages 10-11); (3) further with respect to claim 1, Holstrom and Taskett do not disclose that the size of a multipurpose card is approximately the size of a conventional calling card (Examiner's Answer, page 11); (4) with respect to claim 7, Holstrom and Taskett do not disclose receiving personal information and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information (Examiner's Answer, pages 11-12); (5) with respect to claims 8-11, Holstrom and Taskett do not disclose generating one or more multipurpose calling cards, one or more multipurpose prepaid telephone cards, one or more multipurpose gift cards, or one or more multipurpose credit cards (Examiner's Answer, page 13); (6) with respect to claim 13, Holstrom and Taskett do not disclose adding

personalized information to both the main portion and the keytag portion of each multipurpose calling card (Examiner's Answer, page 13); (7) with respect to claim 29, Holstrom and Taskett do not disclose creating 5 or 6 perforations between the first calling card portion and the second portion (Examiner's Answer, pages 13-14); (8) with respect to claim 2, Holstrom, Taskett, and Small do not disclose a key ring portion including one or more of promotional information, personal expressions, and photographs (Examiner's Answer, pages 14-15); (9) with respect to claim 7, the motivation for combining Holstrom and Small is based on impermissible hindsight (Examiner's Answer, pages 15-16); (10) with respect to claim 30, one skilled in the art would not have been motivated to incorporate the teachings of MacWilliams et al. into the Holstrom system, absent impermissible hindsight (Examiner's Answer, page 16); and (11) further with respect to claim 30, MacWilliams et al. does not disclose placing a label on the perforation that is used to create a first calling card portion and a second portion in the calling card (Examiner's Answer, page 16).

Initially, Appellants note that the Examiner did not address some of the arguments presented in the Appeal Brief. For example, the Examiner did not address the following arguments: with respect to claim 1, the Examiner did not identify the feature that the Examiner relies on Taskett for allegedly teaching (as pointed out in the Appeal Brief, the Examiner appears to rely on Taskett for teaching a feature not recited in Appellants' claim 1); with respect to claim 12, the Examiner did not address the feature recited in that claim; with respect to claim 20, Holstrom and Small do not disclose a processor configured to add at least one of a company logo, personal expression, and a photograph to a main portion and a keytag portion of a

multipurpose card; and the Examiner did not address the feature recited in claim 27.

Accordingly, Appellants contend that the failure to address these arguments is an admission that these arguments are persuasive and Appellants respectfully request that the rejection of these claims be reversed for these reasons and for the reasons set forth in the Appeal Brief.

As to item (1), the Examiner alleges that "Holstrom teaches a card identifier which can be used in accessing a service of a telecommunication network " (Examiner's Answer, page 10). Appellants respectfully disagree.

As set forth in detail in the Appeal Brief, Holstrom is specifically directed to a lost article tracking card and not, as alleged by the Examiner, a calling card. Holstrom in no way discloses or suggests that the lost article tracking card is a calling card, as the term calling card is conventionally used in the art. Moreover, Holstrom discloses that base number 18 and tag number 20 are used to access a specific voice mailbox related to the owner of the lost article tracking card. The mere fact that base number 18 and tag number 20 can be used to access a voice mailbox does not, contrary to the Examiner's allegation, make Holstrom's lost article tracking card a multipurpose calling card.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 1 is patentable over Holstrom and Taskett.

As to item (2), the Examiner alleges that "[a]ccording to Holstrom, one has to dial a 800 number to be connected and then prompted for the identifier (18, 20 of fig. 1) after which one can be given access to a voice mail system connected somewhere in the network and possibly associated with service provider given the fact the dialed number (800) would have to be

completed by a telephone service provider in (see col. 13-22 of Holstrom)" (Examiner's Answer, page 11). Appellants disagree.

It appears that the Examiner believes that it is logical to call anything that has a telephone number written on it a calling card. For example, a cereal box that has a telephone number written on it would be considered a calling card, using the Examiner's rationale. Such illogical claim construction is clearly impermissible.

Figs. 1 and 2 of Holstrom depict front and back views of a two-piece detachable card, including a base 10 and a tag 12, that is used for tracking lost articles. As disclosed by Holstrom, a user may attach tag 12 to an article, such as a key ring, and place base 10 in a secure place, such as a wallet (col. 3, lines 3-8). If the key ring is subsequently lost, the person finding the key ring may call the number 22 listed on tag 12 and leave a voice message for the owner of the key ring (col. 3, lines 9-21). The owner may retrieve the voice message by dialing the number 24 on base 10 (col. 3, lines 22-29).

Contrary to the Examiner's allegation, Holstrom does not disclose or suggest that base 10 is a calling card portion, as required by Appellants' claim 1. By stark contrast, Holstrom's base 10 is merely a card that displays a telephone number that a user may call to retrieve a voice message left by someone finding tag 12. Holstrom is specifically directed to a lost article tracking card. Holstrom in no way discloses or suggests that the lost article tracking card is a calling card, as the term calling card is conventionally used in the art.

For at least the foregoing reasons and for those additional reasons presented in the Appeal

Brief, Appellants submit that claim 1 is patentable over Holstrom and Taskett.

As to item (3), the Examiner alleges that "the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the 'calling' card such as taught by Holstrom. Furthermore, according to Holstrom in (see col.2 lines 49-51) the card can have a scope similar to that of a standard credit card and also, all calling cards do not have the same size. Another feature is that the limitation calls for 'approximately' which would be rendered obvious by the combination based on the explanation above" (Examiner's Answer, page 11).

Appellants submit that the Examiner continues to misinterpret the Holstrom disclosure.

At col. 2, lines 47-53, Holstrom discloses:

A typical embodiment of the two-piece detachable card of the present invention is illustrated in FIG. 1 (front view) and FIG. 2 (back view). In the preferred embodiment, *the two-piece detachable card is flexible plastic similar in scope to a standard credit card*. However the invention can consist of other material such as rubber, wood, metal, cardboard, paper, etc.

(emphasis added). While this section of Holstrom discloses that the two-piece detachable card can be made from a material that is similar to that used in standard credit cards, this section of Holstrom does not disclose or suggest that the size of the two-piece detachable card is approximately the size of a conventional calling card. The Examiner has not pointed to any section of Holstrom that supports the allegation that Holstrom's lost article tracking card is approximately the size of a conventional calling card.

Further with respect to the Examiner's allegation that "the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the 'calling' card

such as taught by Holstrom" (Examiner's Answer, page 11), Appellants note, as set forth in detail in the Appeal Brief, that Holstrom does not, contrary to the Examiner's allegation, disclose or suggest a calling card. Moreover, the mere fact that the disclosure of Holstrom does not put a restriction on the size of the lost article tracking card is merely conclusory and insufficient for establishing a *prima facie* basis of obviousness with respect to a particularly claimed feature.

With respect to the Examiner's allegation that "all calling cards do not have the same size" (Examiner's Answer, page 11), as described on page 5, lines 10-13, of Appellants' specification, conventional prepaid telephone calling cards are approximately 3.375 inches wide and 2.125 inches high. The combination of Holstrom and Taskett do not disclose or suggest a multipurpose card that is approximately the size of a conventional calling card.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 1 is patentable over Holstrom and Taskett.

As to item (4), the Examiner alleges that "personal information is broad and thus can be read on a unique identifier such as a PIN on an article" (Examiner's Answer, page 12).

Irrespective of the veracity of this allegation (i.e., whether or not personal information can be read on a unique identifier, such as a PIN), Holstrom does not disclose or suggest customizing base 10 or tag 12 of the lost article tracking card with a PIN. Therefore, the Examiner's allegation that personal information can be read on a PIN is immaterial since Holstrom does not disclose or suggest customizing the lost article tracking card with a PIN or any other personal information. The Examiner did not point to any section of Holstrom that discloses customizing

base 10 or tag 12 with a PIN.

Further with respect to item (4), the Examiner alleges that "the fact that the personal information can be information customized by a user/purchaser is not directed to the claimed subject matter (claim 7)" (Examiner's Answer, page 12). The Examiner's allegation does not address the fact that Holstrom and Taskett, whether taken alone or in any reasonable combination, do not disclose or suggest receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information, as recited in Appellants' claim 7.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 7 is patentable over Holstrom and Taskett.

As to item (5), the Examiner alleges that "Holstrom teaches a multi-purpose 'calling' card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination (design wise) could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" (Examiner's Answer, page 13). Appellants disagree.

This allegation in no way addresses the specific features recited in Appellants' claims 8-11. Moreover, the Examiner's allegation does not logically explain why one skilled in the art would have been motivated to change Holstrom's lost article tracking card into a multipurpose

calling card, as required by claim 8, a multipurpose prepaid telephone card, as required by claim 9, a multipurpose gift card, as required by claim 10, or a multipurpose credit card, as required by claim 11. Such a modification would change the very operation of the Holstrom system.

Accordingly, the Examiner has not established a *prima facie* basis for denying patentability.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claims 8-11 are patentable over Holstrom and Taskett.

As to item (6), the Examiner alleges that "personal information is broad and thus can be read on a unique identifier such as a PIN on an article" (Examiner's Answer, pages 12-13). Irrespective of the veracity of this allegation (i.e., whether or not personal information can be read on a unique identifier, such as a PIN), Holstrom does not disclose or suggest adding a PIN to base 10 or tag 12 of the lost article tracking card. Therefore, the Examiner's allegation that personal information can be read on a PIN is immaterial since Holstrom does not disclose or suggest adding a PIN (or other personal information) to the lost article tracking card. The Examiner did not point to any section of Holstrom that discloses adding a PIN to base 10 or tag 12.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 13 is patentable over Holstrom and Taskett.

As to item (7), the Examiner alleges that "the combination teaches the possibility of being able to use perforations in separating one portion of a card from another but doesn't specifically limit or mention the number of perforations required to do so. Thus, the examiner in rejecting the claimed limitation believes the combination would render the limitation obvious in part based

on design choice in addition to the fact that there is no restriction on the number of perforations set forth by the combination" (Examiner's Answer, pages 13-14). The Examiner's allegations do not provide the necessary showing to establish a *prima facie* case of obviousness.

It has been consistently held that the initial burden in establishing a *prima facie* case of obviousness is on the Examiner to show that the references expressly or impliedly suggest the claimed invention or, absent such an express or implied suggestion, provide a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious in light of the teachings of the references. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has provided no evidence that Holstrom or Taskett suggest the feature of claim 29. Moreover, the Examiner has not provided a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious in light of the teachings of the Holstrom and Taskett. Accordingly, the Examiner has not established a *prima facie* case of obviousness. The Examiner's allegation that since Taskett does not put a limitation on the number of perforations, creating 5 or 6 perforations between the first calling card portion and the second portion, as recited in Appellants' claim 29, would have been a matter of design choice, is merely conclusory and insufficient for establishing a *prima facie* case of obviousness.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 29 is patentable over Holstrom and Taskett.

As to item (8), the Examiner's allegations on pages 14 and 15 of the Examiner's Answer do not address the specifically recited feature of Appellants' claim 2. The Examiner continues to

ignore the feature of claim 2 and provides allegations regarding features that are not recited in claim 2.

Moreover, the Examiner's allegation that placing company logos and advertisements on a card is notoriously well known, regardless of its veracity, does not address the placement of one or more of promotional information, personal expressions, and photographs on a key ring portion of a multipurpose calling card.

Further with respect to item (8), the Examiner alleges "[i]t would have been obvious to one of ordinary skill in the art that desired information can be placed anywhere on the card as desired by a user or purchaser wherein the personal expressions could including messages or greetings such as taught by Small. The combination including Holstrom teaches personal information (Identifier) on both portions of the card and the possibility of replicating information on both portions ... motivation can be found in the title and disclosure of Small" (Examiner's Answer, pages 14-15). The mere fact that Small discloses electronically dispensing personalized greeting cards and gifts would not lead one skilled in the art to place one or more of promotional information, personal expressions, and photographs on the key ring portion of Holstrom's lost article tracking card. The Examiner has not logically explained why one skilled in the art would have been motivated to place one or more of promotional information, personal expressions, and photographs on the key ring portion of Holstrom's lost article tracking card. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 2 is patentable over Holstrom, Taskett, and Small.

As to item (9), the Examiner alleges "the primary art of record [Holstrom] teaches customizing a card to be used when calling or acquiring a communication service wherein the card has customized information including a telephone number to call and an identifier, possibly unique, on both portions of card which includes a main portion and a key portion. It's known to purchase cards through a vendor, point of sale terminal and so forth. According to Small, a blank or imprinted card s can be customized as desired with any desired information for gift purposes. The combination is believed proper and permissible since no restriction is placed on where the 'calling' card taught by Holstrom can be obtained" (Examiner's Answer, pages 15-16). Initially, Appellants note that, as set forth above and in the Appeal Brief, Holstrom does not disclose customizing the lost article tracking card. The Examiner has not pointed to any section of Holstrom that supports this allegation. Moreover, Small does not disclose or suggest a desire to customize a card that is used for tracking lost articles. Appellants submit that the Examiner's motivation was impermissibly gleaned from Appellants' own disclosure. Without proper motivation to combine Holstrom and Small, the rejection of claim 7 is improper.

The Examiner's allegation that "[t]he combination is believed proper and permissible since no restriction is placed on where the 'calling' card taught by Holstrom can be obtained" (Examiner's Answer, page 16) is in no way directed to the features recited in claim 7.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 7 is patentable over Holstrom and Small.

As to item (10), the Examiner alleges "[t]he combination including Holstrom and Taskett teaches the possibility of using perforations to separate a card into two portions based on

Taskett's teaching of using a perforation for such purpose. Furthermore, the examiner has supplemented the combination with that of MacWilliams to teach the possibility of placing a label member on perforations for stock members for protection purposes and to avoid the possibility of accidentally tearing the cards" (Examiner's Answer, page 16). The Examiner has not pointed to any section of MacWilliams et al. that discloses or suggests placing a label on a perforation, let alone "placing a label member on perforations for stock members for protection purposes and to avoid the possibility of accidentally tearing the cards," as alleged.

Holstrom does not disclose or suggest a desire to place a label on a perforation for protection purposes or to avoid the possibility of accidentally tearing a card. In fact, Holstrom does not disclose or suggest a perforation. Moreover, MacWilliams et al. does not disclose or suggest placing a label on a perforation for protection purposes or avoiding the possibility of accidentally tearing a card. Instead, MacWilliams et al. discloses, as described in the Appeal Brief, a label member 101/501 that is formed on a backing member that includes perforations 111/511. Further, even assuming that MacWilliams et al. discloses placing a label on a perforation, it is unclear as to what form of protection the Examiner alleges the label would provide or how a label can prevent a card from accidentally being torn. Appellants submit that the Examiner's motivation to combine the teachings of MacWilliams et al. with Holstrom's lost article tracking card has been impermissibly gleaned from Appellants' own disclosure.

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 30 is patentable over Holstrom, Taskett, and MacWilliams et al.

As to item (11), the Examiner alleges "the entire means (100) for instance is called a label and (101) is called a label member placed over perforations, which extends to cuts, which can still be considered perforations possibly in a large form, which can be applied to article" (Examiner's Answer, page 16). Appellants disagree.

Figs. 1 and 5 of MacWilliams et al. discloses a label form 100/500 that includes a label member 101/501 that is formed on a backing member that includes perforations 111/511. The perforations allow for the backing member to be bent, thereby facilitating the removal of label member 101/501 (col. 3, lines 32-35 and 47-51; col. 5, lines 25-27). Contrary to the Examiner's allegation, MacWilliams et al. does not disclose or suggest placing a label on a perforation. Instead, labels are removed from label form 100/500 (see, for example, col. 3, lines 9-65).

For at least the foregoing reasons and for those additional reasons presented in the Appeal Brief, Appellants submit that claim 30 is patentable over Holstrom, Taskett, and MacWilliams et al.

CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the outstanding rejections of claims 1-4 and 6-30.

Reply Brief

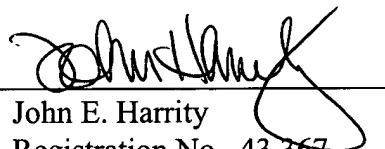
Attorney Docket No. **ATL99003**
Application No. 09/611,196

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By: _____


John E. Harrity
Registration No. 43,367

Date: May 21, 2004

11240 Waples Mill Road
Suite 300
Fairfax, Virginia 22030
(571) 432-0800